

## **REMARKS**

### **Status of the Claims.**

Claims 23-28 and 39-42 are pending with entry of this amendment, claims 32-38 being canceled, and claims 39-42 being added. Claims 23, 24, and 28 are amended herein. Support for new claim 39 is found at least in previous claim 28. Support for new claims 40-42 is found at least in previous claim 23. Therefore, these amendments introduce no new matter.

### **Election/Restriction.**

Pursuant to a restriction requirement made final, Applicants cancel claims with entry of this amendment. Please note, however, that Applicants reserve the right to file subsequent applications claiming the canceled subject matter, and the claim cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

### **Information Disclosure Statement.**

Applicants note with appreciation the Examiner's thorough consideration of the references cited in the Information Disclosure Statement (Form 1449) submitted on December 21, 2006.

### **35 U.S.C. §112, First Paragraph.**

Claims 28 and 32-36 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to satisfy the enablement requirement. Office Action, page 4. The rejection is moot with respect to claims 32-36, which have been canceled, and is respectfully traversed with respect to claim 28.

The rejection of claim 28 was based on the recitation of one or more compounds according to claim 23 and one or more compounds effective in the treatment or prophylaxis of viral infections "in proportions such as to provide a synergistic effect in the said treatment or prophylaxis." The reference to proportions providing a synergistic effect has been deleted from the claim. As amended, claim 28 relates to a composition containing at least one of the compounds of the invention in combination with at least one compound that is effective in the treatment or prophylaxis of viral

infection. Although certain combinations are expected to have additive or synergistic effects with respect to prophylaxis and treatment of viral infection, this is not a requirement of amended claim 28. The specification enables one skilled in the art to produce compounds according to claim 23. To practice claim 28, one must simply add another anti-viral compound to one of the claimed compounds. As this is clearly within the level of skill in the art in view of the guidance provided in the specification, Applicants submit that the specification fully enables claim 28. Withdrawal of the rejection is therefore respectfully requested.

**35 U.S.C. §112, Second Paragraph.**

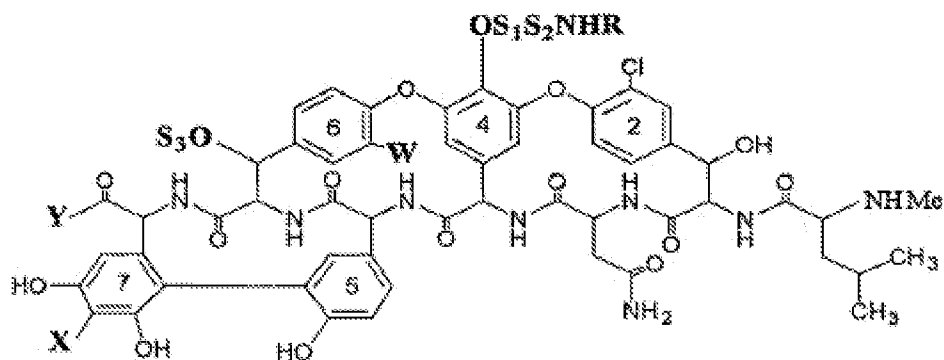
Claims 23-28 and 32-36 were rejected under 35 U.S.C. §112, second paragraph, as indefinite. Office Action, page 9. The rejection is moot as to claims 32-36 and traversed with respect to claims 23-28.

In claims 23 and 24, the Examiner requested that Applicants use the phrase “selected from the group consisting of” to denote a Markush group. *Id.* at page 10. Applicants have amended these claims accordingly.

Claims 25 and 26 were allegedly indefinite and confusing in referring back to code numbers in the description of the application. The Examiner cited *Ex parte Fressola*, 27 USPQ2d 1608 (Bd. Pat. App. & Inter. 1993) for the proposition that incorporation into claims by express reference to the specification is not permitted. *Id.* Applicants Attorney began to attempt to replace the codes in claim 25 with appropriate identifying information from the specification, which resulted in the following:

25. **(currently amended)** The glycopeptide antibiotic or derivative thereof according to claim 23, wherein the derivative is not a compound selected from the ~~of~~ the group consisting of: ~~of~~ compounds referred to with the codes 1 to 55 in the description of this application.

(1) a glycopeptide having the formula:



wherein the glycopeptides is:

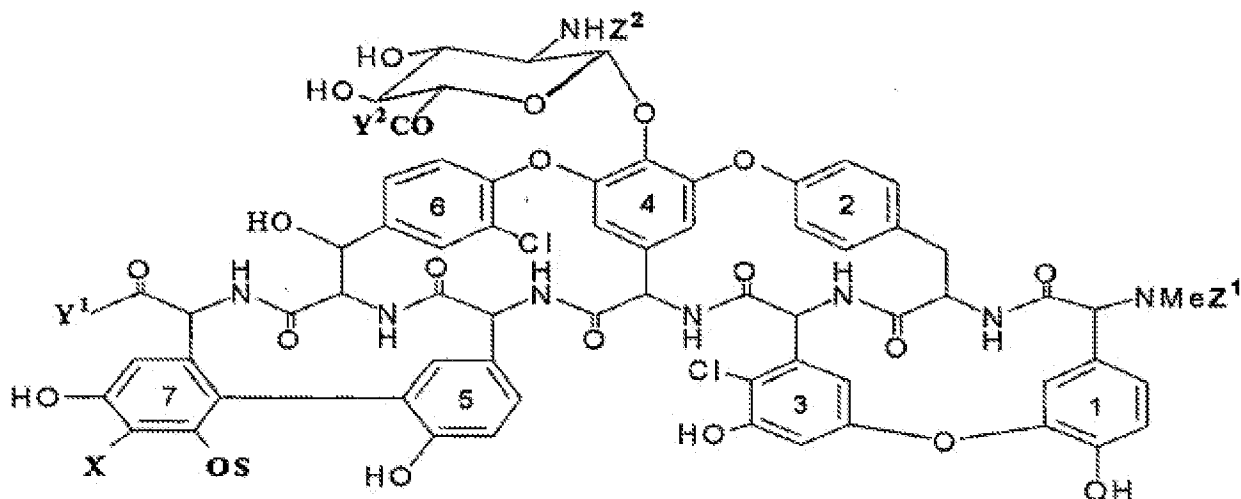
(a) a vancomycin-type glycopeptide selected from the following compounds:

Code no.	X	Y	R	Brutto formula	MW Calc.	MW [M+1H] found
2	H	$\text{NH}(\text{CH}_2)_3\text{N}^+\text{Me}_2$ $\text{C}_{10}\text{H}_{21}$	H	$\text{C}_{81}\text{H}_{108}\text{N}_{11}\text{O}_{23}\text{Cl}_2$	1673	1674
1	$\text{CH}_2\text{N}[\text{CH}_2\text{CH}_2]_2$ $\text{NBnBu-p}$	OH	H	$\text{C}_{82}\text{H}_{99}\text{N}_{11}\text{O}_{24}\text{Cl}_2$	1694	1695

(b) an eremomycin-type glycopeptide selected from the following compounds:

3	$\text{CH}_2\text{NHBnBu-p}$	NHMe	H	$\text{C}_{86}\text{H}_{104}\text{N}_{12}\text{O}_{23}\text{Cl}$	1727	1727
4	$\text{CH}_2\text{NH}(\text{CH}_2)_3\text{N}^+$ $\text{Me}_2\text{C}_{10}\text{H}_{21}$	$\text{NH}(\text{CH}_2)_3\text{NMe}_2$	H	$\text{C}_{94}\text{H}_{136}\text{N}_{14}\text{O}_{23}\text{Cl}$	1895	1896
5	$\text{CH}_2\text{N}[\text{CH}_2\text{CH}_2]_2$ $\text{NBnBu-p}$	NHMe	H	$\text{C}_{79}\text{H}_{116}\text{N}_{13}\text{O}_{23}\text{Cl}$	1813	1814

(2) a glycopeptide having the formula:



wherein the glycopeptide is:

(a) the DA40-like glycopeptide:

10	H	$\text{NH}(\text{CH}_2)_3\text{N}^+\text{Me}_2\text{BuPh-p}$	H	H	$\text{C}_{197}\text{H}_{112}\text{N}_{12}\text{O}_2$ $\text{Cl}_2$	2053	2055
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(b) a DMDA40-like glycopeptides selected from the following compounds:

11	H	$\text{NH}(\text{CH}_2)_3\text{NMe}_2$	p-Bu OB n	p-BuO Bu n	$\text{C}_{97}\text{H}_{108}\text{N}_{12}\text{O}_{21}$ $\text{CH}_3$	1881	1883
12	H	$\text{NH}(\text{CH}_2)_3\text{NMe}_2$	H	p-BuB n	$\text{C}_{86}\text{H}_{94}\text{N}_{12}\text{O}_{21}$ $\text{Cl}_2$	1703	1705
13	$\text{CH}_2\text{N}[(\text{CH}_2\text{CH}_2)_2\text{NBuPh}]_2\text{P}$	$\text{NH}(\text{CH}_2)_3\text{NMe}_2$	H	p-BuB n	$\text{C}_{166}\text{H}_{114}\text{N}_{14}\text{O}_2$ $\text{Cl}_2$	1967	1969
14	$\text{CH}_2\text{NH}(\text{CH}_2)_3\text{N}^+\text{C}_{10}\text{H}_{21}\text{Me}_2$	$\text{NH}(\text{CH}_2)_3\text{NMe}_2$	H	H	$\text{C}_{91}\text{H}_{115}\text{N}_{14}\text{O}_{21}$ $\text{Cl}_2$	1812	1814

After having listed 10 of the 55 recited compounds in this manner, Applicants Attorney realized that such an amendment would render the claim much less comprehensible than the references to compound code numbers from the specification. Applicants note that M.P.E.P § 2173.05(s) states:

*Where possible*, claims are to be complete in themselves. Incorporation by reference to a specific figure or table "is *permitted only in exceptional circumstances where there is no practical way to define the invention in*

*words and where it is more concise to incorporate by reference* than duplicating a drawing or table into the claim. Incorporation by reference is a necessity doctrine, not for applicant's convenience." Ex parte Fressola, 27 USPQ2d 1608, 1609 (Bd. Pat. App. & Inter. 1993) (citations omitted).

(Emphasis added.) Applicants submit that claims 25 and 26 present the exceptional circumstances that justify deviation from the rule that claims are to be complete. The compound code numbers are analogous to the sequence identifiers used to identify nucleic acid and amino acid sequences. The USPTO has recognized that it is preferable for claims to refer to these sequence identifiers, rather than reciting entire nucleic/amino acid sequences. By the same token, Applicants submit that claims 25 and 26 clearer and easier to understand as previously presented. Withdrawal of the rejection of these claims is therefore respectfully requested.

Claim 28 was rejected on the ground that the recitation "in proportions" was unclear. As this language has been deleted from claim 28, this rejection is moot.

Claim 28 was also rejected for reciting "compounds effective in the treatment or prophylaxis of viral infections, *including* Retroviral, Flaviviral, Herpes or Coronaviral enzyme or entry inhibitors. The "including" clause has been deleted from claim 28. Accordingly, the rejection is also moot.

### **Conclusion.**

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Should the Examiner seek to maintain the rejections, Applicants request a telephone interview with the Examiner and the Examiner's supervisor.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 267-4160.

Any required fees accompany this response; if the amount of such fees is incorrect, please charge any required fees, or credit any overpayments, to Deposit Account No. 500388 (Order No. CHIRP019US).

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Respectfully submitted,

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